



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/972,313	11/18/1997	THOMAS BOONE PICKENS III	2281	5434

21552 7590 12/17/2002

MADSON & METCALF
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY, UT 84101

EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/972,313

Applicant(s)

PICKENS, THOMAS BOONE

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

Applicant: Thomas Boone Pickens III

Filing date: 11/18/97

Part III Action on the Merits

Claim Rejections - 35 USC § 102

5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

10 (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15 The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

20 Claims 1-2, 4-6, 9, 15-18, 20, and 25-26 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #5,869,819 to Knowles et al. ("Knowles" hereinafter). Knowles discloses an optical scanning system for scanning graphical codes which are displayed on an object, comprising:

 an object comprising:

25 text displayed on the object (e.g. the URL, see figure 6b, 8 and elsewhere; or the conventional name and address, see column 20, line 5); and

 at least one two dimensional graphical code displayed on the object (see column 21, lines 54-64), wherein the graphical code comprises an encoded Internet address (URL) and additional information (zip code);

 scanning means (e.g. 53A) for optically scanning the graphical code; and

30 a computer (e.g. 53C) connected to the scanning means and further comprising processing means for decoding the scanned encoded Internet address and additional information (see figures 15 and 16, and elsewhere).

 Re claim 6, Knowles clearly depicts a detachable scanner 7A in figure 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7, 8, 12-13 drawn to an optical scanning system, and claims 19, 21-24 drawn to an optical scanning method, and claim 27, drawn to a process of printing a graphical code are rejected under 35 U.S.C. § 103 as being unpatentable over Knowles.

Re claim 3, a wireless connection link to an ISP is taught by Knowles in column 8, lines 11-27, and in figure 17 as well known in the art. Wireless modems were well known in the art at the time the invention was made for connecting to the Internet, and this is clearly suggested by Knowles. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a well known wireless modem to connect to the Internet as depicted in figure 17 because a wireless modem accomplishes the wireless link from a hand held unit to a server computer as depicted in figure 17 of Knowles.

Re claim 7, Official Notice is taken that wireless Infrared scanners were old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use an wireless infrared scanner to perform the wireless link suggested by Knowles because Knowles relies on wireless links known in the art without specifying the details and wireless infrared links were well known in the art.

Re claim 8 and 19-21 and 22, see figure 4. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the embodiments shown in figure 4 and figures 11-18 because this would allow a user to use known free web browsers to perform the invention of figures 11-18. This is clearly suggested by the teaching as a whole.

Re claim 12-13 and 23-24, note that the bar code on the top of the Knowles patent is approximately 7mm high. Smaller bar code heights are old and well known.

Re claims 14 and 27, the zip code is included. If the complete zip plus 4 is included, this would be all the information needed in many cases to deliver the parcel. Alternatively, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to encode the zip code plus the entire address of the intended recipient, in order to facilitate routing the package more completely.

Conclusion

Applicant's arguments with respect to claims 1-9 and 13-7 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

December 14, 2002